

REMARKS

The Office Action dated July 26, 2005 has been carefully considered. Claims 1-4, 6-8 and 10-20 are pending in the application, with claim 1 being the only independent claim and claims 6-7, 11-17 and 20 being withdrawn from consideration.

Claim 1 has been amended to correct an error. As illustrated in Fig. 1, the valve chamber (14, 14') is in the piston (2), not in the volume equalizing space (20). Other pending claims have been amended. Reconsideration of the application, as amended herein and in view of the following remarks, is respectfully requested.

Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over the shock absorber shown in Fig. 5 of U.S. Patent No. 3,625,321 (Lutz) in view of the shock absorber shown in Fig. 1 of Lutz. Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness because Lutz does not disclose or suggest, either expressly or inherently, each and every element as set forth in claim 1.

The Examiner acknowledged (Office Action, page 3, first full paragraph) that in Fig. 5 of Lutz the volume equalizing space is not in the piston. However, the Examiner failed to notice that Lutz additionally does not disclose (1) the first and second non-return valves, the first and second biased valves, and the volume equalizing space are all positioned in the same piston; and (2) the first or second biased valve has a closing element.

In particular, Lutz uses two separate pistons 2 and 3. Col. 1, lines 31-34 and 66-68; Figs. 1 and 5. A spring biased valve and an alleged non-return valve are positioned in the piston 2. Similarly, a spring biased valve and an alleged non-return valve are positioned in the piston 3. See Fig. 5. A cylinder compartment 10, which functions as a volume equalizing space, is positioned between the piston 2 and the piston 3 (see Fig. 1) or outside the shock absorber completely (see Fig.

5). In contrast, claim 1 recites one piston. The first and second non-return valves, the first and second biased valves, and the volume equalizing space are all positioned in the same piston.

Furthermore, as far as Applicants can tell from a review of Fig. 5, each of the spring biased valves of Lutz does not have a valve piston and a closing element, as recited in claim 1. Lutz uses flap valves. Col. 1, lines 71-75. Thus, Lutz does not disclose or suggest a valve piston and a closing element combination. If the Examiner considers the horizontally positioned element of each spring biased valve in Fig. 5 of Lutz to be a closing element, then such a closing element is not coupled to any valve piston, let alone extending between a valve piston and a mouth, as recited in claim 1. If the Examiner considers the horizontally positioned element to be a valve piston (which is not), then such a valve piston is not displaceably mounted within a valve chamber, and there is no closing element coupled to the valve piston and extending between the valve piston and a mouth, as recited in claim 1. In contrast, in claim 1, at least one of the biased first and second valves has (a) a valve chamber in the main piston and having a mouth, (b) a valve piston displaceably mounted within the valve chamber, and (c) a closing element coupled to the valve piston and extending between the valve piston and the mouth.

In view of these differences, withdrawal of the 103(a) rejection of claim 1 is respectfully requested.

Dependent claims 2-4, 8, 10 and 18-19 are patentable for at least the same reasons that independent claim 1 is patentable, as well as for the additional limitations recited therein.


Applicants respectfully submit that the amendments to the claims do not raise any new issues that would require further consideration and/or search by the Examiner.

Applicants respectfully request entry of this Amendment and submit that the application is in condition for allowance, and such action is respectfully requested.

It is believed that no fees or charges are required at this time in connection with the application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 

Thomas C. Pontani
Reg. No. 29,763
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: October 21, 2005